

**REMARKS**

Claims 1-8 and 23-26 were pending in this application. Claims 1-7 and 8 (in part) were withdrawn from further consideration by the Examiner as being drawn to non-elected inventions under 37 C.F.R. §1.142(b). Claim 23 has been amended, and claim 24 has been canceled. Support for currently amended claim 23 can be found throughout the specification as filed, including, *e.g.*, originally filed claim 24. Claim 8, 23 and 25-26 will be pending upon entry of this amendment.

**Claim rejections under 35 U.S.C. §103(a)**

The Examiner has rejected claim 8 in part (specifically the 6<sup>th</sup>, 7<sup>th</sup>, 8<sup>th</sup>, 10<sup>th</sup>, 14<sup>th</sup>, and 15<sup>th</sup> compounds) under 35 U.S.C. §103(a) as being unpatentable over Chalifour *et al.*, WO 2003/017994. The Examiner states that the instant claimed compounds (the 6<sup>th</sup>, 7<sup>th</sup>, 8<sup>th</sup>, 10<sup>th</sup>, and 15<sup>th</sup> compounds in claim 8) “would have been obvious because on[e] skilled in the art would have [been] motivated to prepare homologs of the compounds taught by Chalifour with the expectation of obtaining compounds which could be used in pharmacology.” The Examiner further states that “one skilled in the art would have found the claimed compounds (the 14<sup>th</sup> compounds [sic] in Claim 8) *prima facie* obvious because it is well established that nothing unobvious is seen in substituting the known claimed isomers, as taught by Chalifour *et al.*, since such structurally related compounds suggest one another and would be expected to share common properties absent a showing of unexpected results.”

Applicants respectfully submit that Chalifour *et al.* is not available as prior art against the instant application, at least because the claimed invention was completed in Canada prior to March 6, 2003, the publication date of the Chalifour *et al.* reference. Submitted herewith in support of this position, is a Declaration Under 37 C.F.R. §1.131 by the inventors, together with an Appendix evidencing completion prior to the publication date of Chalifour *et al.* Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejection of claim 8 under 35 U.S.C. §103(a).

**Status of the Claims**

Claims 1-8 and 23-26 are pending in this application. Claims 1-7 and 8 (in part) were withdrawn from consideration by the Examiner as being drawn to non-elected inventions under 37 C.F.R. §1.142(b).

Applicants respectfully submit that in view of the above argument, and the Declaration submitted herewith, the examined portion of claim 8 is allowable, and accordingly, the examination of the currently pending claims should be extended to the extent necessary to determine patentability of the entire claim in accordance with MPEP §803.02.

**Claim Objections**

The Examiner has objected to claim 8 for containing non-elected subject matter, and claims 23-24 for depending on a rejected base claim (claim 8). Applicants respectfully submit that based on the arguments presented above, examination of claim 8 should now be extended to the non-elected compounds of claim 8 to the extent necessary to determine patentability of the Markush-type claim, as stated in MPEP §803.02. As such, the Applicants respectfully request that the objection to claim 8 for containing non-elected subject matter be withdrawn.

The Examiner has also objected to claims 25-26 under 37 C.F.R. §1.75 as being substantial duplicates of claims 23-24. Applicants submit that the cancellation of claim 24 and the amendment to claim 23 addresses the Examiner's objection.

**CONCLUSION**

In view of the above response, Applicants believe the pending application is in condition for allowance. The Examiner is invited to contact the undersigned (direct dial: 617.994.0853) with any questions or comments regarding this Response.

Please charge any underpayment and credit any overpayment to our Deposit Account No. 12-0080, under Order No. NBI-193 from which the undersigned is authorized to draw.

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Respectfully submitted,

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